

1 REMARKS

2 Preliminary Remarks

3 Claims 1-7, 9-22 and 24-25 are pending in the application. Claims 1 and 19
4 are hereby amended. Claims 8 and 23 are hereby cancelled without prejudice.
5 Claims 24 and 25 are added. The issues in the application are as follows:

- 6 • Claims 1, 4-12, 14-16 and 18-23 have been rejected under 35 U.S.C. § 102(e)
7 as being anticipated by U.S. Patent 6,347,398 to Parathasarathy et al.
8 (hereinafter, "Parathasarathy").
- 9 • Claims 2-3, 13 and 17 have been rejected under 35 U.S.C. § 103(a) as being
10 unpatentable over Parathasarathy.

11 In response, Applicant hereby traverses the outstanding rejections of claims
12 1-23 and requests reconsideration and withdrawal in light of the amendments and
13 remarks contained herein.

14 Support for the amendment to claim 1 is provided at least by original claim 8
15 and by Applicant's specification at page 5, lines 5-6. Support for the amendment to
16 claim 19 is provided at least by original claims 8 and 23 and by Applicant's
17 specification at page 5, lines 5-6. Support for the new claim 24 is provided at least
18 by Applicant's specification at page 8 lines 13-14. Support for new claims 25 is
19 provided at least by Applicant's specification at page 8 lines 13-14. No new matter
20 has been added.

21 The Applicant contends that claims 1-7, 9-22 and 24-25 are allowable, for at
22 least the reasons stated below.

23 Rejection of Claims under 35 U.S.C. § 102(e)

24 Claims 1, 4-12, 14-16 and 18-23 have been rejected under 35 U.S.C. § 102(e)
25 as being anticipated by Parathasarathy. In the following arguments, the Applicant
will focus in particular on independent claims 1 (as amended), 10 and 19 (as
amended), as the Applicant believes those claims to be allowable over the cited art.
It is axiomatic that any dependent claim which depends from an allowable base
claim is also allowable, and therefore the Applicant does not believe it is necessary
to present arguments in favor of each and every claim that depend from claims 1, 10,
and 19.

1 As a starting point, the PTO and the Federal Circuit provide that §102
2 anticipation requires each and every element of the claimed invention to be
3 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d
4 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited
5 §102 reference of any claimed element negates the anticipation. (*Kloster*
6 *Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
7 1986)). Furthermore, “[a]nticipation requires that all of the elements and limitations
8 of the claims are found within a single prior art reference.” (*Scripps Clinic and*
9 *Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010
10 (Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit
11 provide that §102 anticipation requires that there must be no difference between the
12 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*
13 *v. Genetech, Inc.*, *id.* (emphasis added))). Accordingly, if Applicant can demonstrate
14 that any one element or limitation in the claims is not disclosed by the cited
15 reference, then the respective claim(s) must be allowed.

14 Claim 1

15 Claim 1 (as amended) now recites:

16 A method of providing software to a user for subsequent use by a
17 particular user device, comprising:

18 providing a user interface configured to allow the user to identify the
19 particular user device;

20 **locating the user interface in a retail sales location where the**
21 **particular user device is offered for sale to the user;**

22 identifying the particular user device via the user interface;

23 accessing software specific to the particular user device;

24 storing the software on a computer readable medium; and

25 making the computer readable medium available to the user.

(Emphasis added.)

While The Examiner contends in the Office action (paper number 7, page 3)
that Parathasarathy teaches “locations of retail sales,” it is not clear from the
Examiner’s citation which retail sales locations the Examiner is referring to.
Furthermore, the Applicant is unable to identify the Examiner’s citation to a “page 2,

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lines 22-23" as it appears in the Office action (number 7, page 3). Regardless, the words "retail" and "sales" never occur anywhere in the disclosure of Parathasarathy. Furthermore, the word "location" as used in Parathasarathy never refers to a physical place where retail sales to users occur. The Applicant's claim 1, as amended, requires "locating a user interface in a retail sales location where the particular user device is offered for sale to the user." Parathasarathy never teaches, discloses or even suggests "locating a user interface in a retail sales location where the particular user device is offered for sale to the user," and therefore Parathasarathy cannot anticipate Applicant's claim 1. Applicant therefore contends that, for at least the above reasons, claim 1 (as amended) and claims 2-7, 9 and 24 that depend from claim 1 (as amended) are all allowable over Parathasarathy.

Claim 10

Claim 10 recites:

An apparatus for providing software to a user for use by a particular user device, comprising:

a user interface configured to allow a user to **select the particular user device from a plurality of user devices** and to generate a user input signal in response thereto;

a communication device configured to connect to a computer network;

a computer readable medium writing device; and

a processor configured to receive the user input signal, to use the user input signal to retrieve software specific to the particular user device, and to store the software on a computer readable medium using the computer readable medium writing device.

(Emphasis added.)

The Examiner contends that Parathasarathy anticipates Applicant's claim 10, and relies in part on Parathasarathy at col.7, lines 26-31 and 58-61 for support of this contention. However, claim 10 requires "a user interface configured to allow a user to **select the particular user device from a plurality of user devices**,". Parathasarathy never discloses, teaches or even suggests this limitation.

1 Parathasarathy instead teaches, "When used for browsing documents, the illustrated
2 browser displays the document in a window 50 or area of the local computer's 36
3 display 20 allocated to the browser by the operating system. The illustrated window
4 50 comprises a document display area 52 and user interface controls 54." (col.7,
5 lines 26-31), and "The browser or other client application patches the document's file
6 name into the text string command and invokes the operating system's shell execute
7 service to execute the command." (col.7, lines 58-61). Accordingly, information is
8 selected by identifying a specific file in a browser, rather than via "a user interface
9 configured to allow a user to **select the particular user device from a plurality of**
10 **user devices**", as is required by Applicant's claim 10. Therefore, since
11 Parathasarathy does not disclose each and every element of Applicant's claim 10,
12 Parathasarathy cannot anticipate Applicant's claim 10. Applicant contends that, for
13 at least this reasons, claim 10 and claims 11-18 that depend from claim 10 are
14 allowable over Parathasarathy.

15 Claim 19

16 Claim 19 (as amended) now recites:

17 A computer network system for providing software to users of a plurality of
18 user devices, comprising:

19 a user station comprising a first processor, a user interface in signal
20 communication with the first processor, a first communication device in
21 signal communication with the first processor, a first computer readable
22 memory device in signal communication with the first processor, and a
23 computer readable medium writing device in signal communication with
24 the first processor, **the user station located in a retail store which**
25 **offers the user devices for sale;**

(Emphasis added.)

26 Claim 19 (as amended) specifies that "the user station [is] located in a retail
27 store which offers the user devices for sale." For the reasons discussed above with
28 reference to claim 1, Parathasarathy never discloses, teaches or even suggests that
29 "the user interface is located in a retail sales location", such as a store, "where the
30 particular user device is offered for sale to the user." Therefore, Parathasarathy

1 cannot anticipate Applicant's claim 19. Applicant contends that for at least the above
2 reasons, claim 19 (as amended) and claims 20-22 and 25 that depend from claim 19
3 (as amended) are allowable over Parathasarathy.

4 Rejection of Claim under 35 U.S.C. § 103(a)

5 Dependent claims 2-3, 13 and 17 have been rejected under
6 35 U.S.C. § 103(a) as being unpatentable over Parathasarathy.

7 With regard to 103(a) rejections for obviousness, MPEP 706.02(j) states:

8 "[t]o establish a *prima facie* case of obviousness, three basic
9 criteria must be met. First, there must be some suggestion or
10 motivation, either in the cited references themselves or in the
11 knowledge generally available to one of ordinary skill in the art, to
12 modify the reference or to combine the reference teachings. Second,
13 there must be a reasonable expectation of success. Finally, the prior
14 art reference (or references when combined) must teach or suggest all
15 the claim limitations."

16 Applicant respectfully submits that the rejection of claims 2-3, 13 and 17 is
17 improper. Claims 2-3 depend from independent claim 1 (as amended). Claims 13
18 and 17 depend from independent claim 10. For the reasons stated above with
19 reference to claims 1 and 10, Parathasarathy does not disclose, teach, or even
20 suggest all of the limitations of claims 1 and 10. Therefore, Parathasarathy cannot
21 render claims 2-3, 13 and 17 obvious under 35 U.S.C. § 103(a). It is axiomatic that a
22 claim that depends from an allowable claim is also allowable for at least the reasons
23 for the allowability of the claim from which it depends. For at least these reasons
24 Applicant contends that claims 2-3, 13 and 17 are all allowable over the cited art.

24 Summary

25 The Applicant believes that this response constitutes a full and complete
response to the Office action, and therefore requests timely allowance of claims 1-7,
9-22 and 24-25.

1 The Examiner is respectfully requested to contact the below-signed
2 representative if the Examiner believes this will facilitate prosecution toward
3 allowance of the claims.

4 Respectfully submitted,

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6 Date: February 9, 2005

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